



**Amendments to the Drawings:**

Fig. 1 has been amended pursuant to 37. C.F.R. 1.121 (d). A replacement sheet 1/5 containing amended Fig. 1 is submitted herewith as Exhibit 1 pursuant to MPEP 608.02(t). Specifically, new reference numeral **52** has been added to properly identify the locking bar that was previously mislabeled under reference numeral **32**. Also, new reference numerals **53** and **54** have been added to identify the opposite ends of locking bar **52**. Existing reference numeral **32** has been moved to the right of new reference numeral **53** to properly identify the top channel that is formed between locking bar **52** and the raised surface on housing receiving portion **24** that flanks bottom channel **34**. Amended Fig. 1 is believed to be in compliance with 37 C.F.R. 1.84.



## **REMARKS/ARGUMENTS**

Applicant has studied the Office Action of February 8, 2005 and made amendments to the specification, claims and drawings, as indicated hereinabove, to place the application in condition for allowance. No new matter has been added.

Claim 1 has been amended to define Applicant's invention over the cited prior art. Claims 2 - 24 have been cancelled without prejudice. New claims 25 - 39 have been added, as indicated hereinabove. Therefore, claims 1 and 25 - 39 are presently pending.

### **Claim Rejections Under 35 U.S.C. §102**

Claims 1, 6, 16 and 22 stand rejected under 35 U.S.C. §102(b) as being anticipated by Newman et al (U.S. Patent Application Publication 2002/0143352 A1). Newman et al disclose a shielded surgical scalpel with an elongated handle defining a longitudinal axis and having a proximal portion and a distal portion. A blade is fixedly attached to the handle. A shield is mounted onto the handle. The shield is movable between a distal position in which the shield prevents inadvertent access to the blade and a proximal position in which the shield exposes the blade for use.

The Examiner asserts that the Newman et al reference anticipates Applicant's claimed invention, as shown, for example in Figs. 1 - 7.

Applicant respectfully submits that the presently claimed invention is patentably different from the shielded surgical scalpel structure of Newman et al. Specifically,

there is no teaching in Newman et al in regard to an actuator (on a blade housing) configured to disengage a blade (that is internally retained by the blade housing) from a front handle portion when the blade housing is in a second position defined by the sharp end of the blade being fully enclosed within the blade housing for safety, as recited in amended claim 1.

Newman et al teaches away from the claimed invention by only reciting an “upwardly biased cantilevered digital activation section 41 projecting upwardly from the top surface of shield 40. A clinician may apply digital pressure to upwardly biased cantilevered digital activation section 41 sufficient to downwardly deflect digital activation section 41 and release shield 40 for movement between the proximal position and the distal position. Upwardly biased cantilevered digital activation section 41 preferably includes at least one inwardly directed boss 42 designed to cooperate with a slot 21 formed in handle 20 to control movement of shield 40 between the distal position and the proximal position. If two slots are formed in handle 20 on either side thereof, preferably two inwardly directed bosses 42 are formed on cantilevered digital activation section 41”, Par. [0030], Pages 2 – 3, see Figs. 1 – 5. Newman et al fails to recite a blade disengaging actuator on shield 40 (Figs. 1 – 2) in the manner presently claimed by Applicant.

Applicant respectfully submits that for a reference, such as the Newman et al reference, to function under 35 U.S.C. §102(b), the reference must within the four corners of that document disclose each and every element that is set forth in the claim against which it is applied. Furthermore, every element of the claimed invention, as

recited in the claims, must be disclosed either specifically or inherently by a single prior art reference. See, *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed.Cir.1992); *Scripps*, 927 F.2d at 1576-77; *Lindemann Maschinenfabrik GMBH, v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed.Cir.1984).

Since the Newman et al reference does not anticipate in any way the invention, as recited in amended claim 1, Applicant respectfully requests withdrawal of the 102(b) claim rejections in regard to this claim. Claims 6, 16 and 22 have been canceled, as indicated hereinabove, rendering the Examiner's rejections thereto moot.

In view of the foregoing amendments and remarks, Applicant respectfully requests withdrawal of the 102(b) claim rejections.

#### **Claim Rejections - 35 U.S.C. § 103**

Claims 2 - 3 and 7 - 9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al in view of Takase (U.S. Patent 5,078,724). Claims 2 - 3 and 7 - 9 have been canceled, as indicated hereinabove, rendering the Examiner's claim rejections thereto moot.

Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al in view of Takase, and further in view of Machida (U.S. Patent 4,922,614). Claim 4 has been canceled, as indicated hereinabove, rendering the Examiner's claim rejections thereto moot.

Claims 5, 10 - 15, 17 - 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al in view of Takase, and further in view of Herbert et al (U.S. Patent 5,868,771). Claims 5, 10 - 15, 17 - 21 have been canceled, as indicated hereinabove, rendering the Examiner's claim rejections thereto moot.

Claims 23 - 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al in view of Davison et al (U.S. Patent 5,324,299). Claims 23 - 24 have been canceled, as indicated hereinabove, rendering the Examiner's claim rejections thereto moot.

In view of the foregoing amendments and remarks, Applicant respectfully requests withdrawal of the 103(a) claim rejections.

### **Conclusion**

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Applicant believes that the claimed invention, as amended, is in condition for allowance. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the telephone number listed herein below to discuss any steps necessary to place the application in condition for allowance.

In the event that any fees are due, the Examiner is authorized to charge our

Application No. 10/800,306  
Amendment dated May 9, 2005  
Reply to Office Action of 02/08/05  
Attorney Docket No. 03-12896

USPTO Deposit Account # 03-2030. A duplicate of this authorization is enclosed.

Date: May <sup>9<sup>h</sup></sup> \_\_\_, 2005

DMC/MM:cjh

Enclosures:

Acknowledgement Postcard

CISLO & THOMAS LLP  
233 Wilshire Boulevard, Suite 900  
Santa Monica, California 90401  
Tel: (310) 451-0647  
Fax: (310) 394-4477  
www.cislo.com

Respectfully submitted,

CISLO & THOMAS LLP



Daniel M. Cislo, Esq.

Reg. No. 32,973

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Daniel M. Cislo, Reg. No. 32,973

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Date

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